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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,130

12/18/2006

Mikhail S. Shchepinov

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EXAMINER

SISSON, BRADLEY L

ART UNIT

PAPER NUMBER

1634

NOTIFICATION DATE

DELIVERY MODE

05/24/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

euspto@slspatents.com

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/574,130</p>	<p>Applicant(s) SHCHEPINOV ET AL.</p>	
	<p>Examiner Bradley L. Sisson</p>	<p>Art Unit 1634</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 May 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: 72.
Claim(s) rejected: 58-87.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Bradley L. Sisson/
Primary Examiner
Art Unit: 1634

Continuation of 3. NOTE: the listing of claims submitted 10 May 2010 has not been found to comprise any amendment.

Continuation of 11. does NOT place the application in condition for allowance because: At page 9 of the response argument is presented that claim 72 does further limit claim 58 from which it depends. In support of this position, attention is directed to page 20 of the specification, and argument is presented that "The direct labeling of claim 72 refers to a link with the nucleotide that is, for example, covalent. That claim 72 recites that there is direct labeling does not mean that the label is not attached to the nucleotide via a cleavable linker."

The above arguments have been considered and have not been found persuasive. It is noted with particularity that narrowing limitations found in the specification cannot be inferred in the claims where the elements not set forth in the claims are linchpin of patentability. In re Philips Industries v. State Stove & Mfg. Co, Inc., 186 USPQ 458 (CA6 1975). While the claims are to be interpreted in light of the specification, it does not follow that limitations from the specification may be read into the claims. On the contrary, claims must be interpreted as broadly as their terms reasonably allow. See Ex parte Oetiker, 23 USPQ2d 1641 (BPAI, 1992). Accordingly, the objection is maintained.

Agreement is reached with applicant at page 10 of the response that, in accordance with claim 58, the label is cleaved from the nucleotide subsequent to the nucleotide being incorporated and detected.

At page 10 of the response argument is presented that the specification enables the sequencing of multiple nucleic acids and that the method may comprise wash steps. The argument has been considered and has not been found persuasive. As set forth above, limitations found in the disclosure are not read into the claims.

At pages 10-14 of the response applicant makes assertions as to what one of skill in the art would have been able to understand and achieve. This argument has been fully considered and has not been found persuasive. Attention is directed to MPEP 2145.

"Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art.

The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465,

43 USPQ2d 1362 (Fed. Cir. 1997) ('An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.'). See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration."

At page 12 of the disclosure applicant directs attention to the publication of Mir et al. as exemplifying a means of conducting nucleic acid sequencing. It is noted that the instant application claims benefit of priority to foreign application filed 20 October 2003. By contrast, the article by Mir et al., was not published until some 6 years later. Accordingly, the article by Mir et al., does not establish the state of the art at the time of filing.

Argument is also advanced that applicant needs not set forth reaction conditions so to enable the chemicals specifically recited in the claims, asserting that "only a reasonable amount of detail must be provided in order to enable members of the public to understand and carry out the invention." The above argument has not been found persuasive towards the withdrawal of the rejection for lack of enablement. While an applicant is not required to teach each and every conceivable embodiment encompassed by the claims, applicant is still required to enable the full scope of the claimed invention. Such full enablement, even for those embodiments explicitly claimed, is not to be found in the instant disclosure. For the above reasons, and in the absence of convincing evidence to the contrary, the rejections are maintained.